

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Gary VAN NEST et al.

Application No.: 09/642,492

Confirmation No.: 7136

Filed: August 18, 2000

Art Unit: 1648

For: METHODS OF MODULATING AN IMMUNE
RESPONSE USING IMMUNOSTIMULATORY
SEQUENCES AND COMPOSITIONS FOR
USE THEREIN

Examiner: E. Le

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR § 1.705

MS Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

On behalf of Applicants, the undersigned requests reconsideration of the patent term adjustment indicated in the Notice of Allowance. This application for patent term adjustment is being filed with payment of the issue fee and is, therefore, timely. The fee required under 37 CFR § 1.705(b)(1) as set forth in 37 CFR § 1.18(e) is enclosed with the present application.

Correct Patent Term Adjustment

Applicants respectfully request an additional credit of 27 days to be added to the 764 days of adjustment as indicated on the Notice of Allowance. The additional credit, minus Applicants' delay, results in a revised total of 791 days of patent term adjustment.

Statement of Facts

According to the Office's Initial Determination of Term Adjustment received with the Notice of Allowance, mailed August 14, 2008, Applicants are entitled to 764 days adjustment of patent term. Applicants disagree with the Patent Term Adjustment of 764 days and reconsideration is respectfully requested.

Applicants filed a Response by Express Mail on January 30, 2002 to an Office Action mailed July 30, 2001, resulting in 92 days of delay (as correctly calculated by the Office).

Applicants filed a Notice of Appeal and a Response to the Final Office Action mailed April 23, 2002 on October 23, 2002 by Express Mail, resulting in 92 days of delay (as correctly calculated by the Office).

A Request for Continued Examination (RCE) was filed on January 23, 2008 by First Class mail. This RCE was received by the Office on February 13, 2003.

The USPTO considered the Response received by the Office on March 12, 2003 as a Supplemental Response resulting in a loss of 27 days of adjustment. However, 37 CFR § 1.704(c)(8) indicates that Supplemental Responses do not cause patent adjustment if they are expressly requested by the Examiner. The Interview Summary mailed February 24, 2003 stated that "[i]f a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW." Also, the box next to the statement "[i]t is not necessary for applicant to provide a separate record of the substance of the interview (if box is checked)" was not checked, indicating that a Response was required. Thus, the Examiner expressly requested a Response to the Interview Summary.

A Reply to the last Office Action had already been filed on January 23, 2003 with the RCE. Thus, a Response to the Interview Summary was filed on March 6, 2003 by First Class Mail and received by the Office on March 12, 2003, which is within one month of the February 24, 2003

Interview Summary. Accordingly, the Response to the Interview Summary was timely filed. The Response to the Interview Summary stated “[a]s box i on the Interview Summary was unchecked, Applicants are required to file a statement of substance of the interview. Since a response to the last Office Action was filed prior to the mailing of Interview Summary, Applicants are herein providing the required statement.” The Office classified this as a “Supplemental Response” and deducted 27 days of PTA as Applicants’ delay. As the Response to the Interview Summary was expressly requested by the Examiner and filed in a timely manner, it is believed that there was no delay on the part of the Applicants in filing the Response to the Interview Summary. Thus, the 27 days between the Interview Summary and the Response to the Interview Summary should not be counted as Applicants’ delay.

Applicants filed a Response by First Class Mail on September 2, 2003 to an Office Action mailed June 2, 2003. This Response was received by the Office on September 4, 2003, resulting in 2 days of delay (as correctly calculated by the Office).

The Office failed to mail an Office Action within 4 months of the Response received September 4, 2003 from Applicants. In particular, an Office Action was mailed March 9, 2004, resulting in a credit of 65 days of adjustment (as correctly calculated by the Office).

Applicants filed a Response by First Class Mail on June 9, 2004 to the Office Action mailed March 9, 2004. This Response was received by the Office on June 14, 2004, resulting in 5 days of delay (as correctly calculated by the Office).

The Office failed to mail an Office Action within 4 months of the December 22, 2004 Response by the Applicants. In particular, an Office Action was mailed June 13, 2005 resulting in a credit of 52 days of adjustment (as correctly calculated by the Office).

Applicants filed a Notice of Appeal and a Response to the Final Office Action mailed June 13, 2005 on December 12, 2005 by Express Mail, resulting in 90 days of delay (as correctly calculated by the Office).

Applicants received a favorable decision by the Board of Patent Appeals and Interferences on July 23, 2008, resulting in a credit of 955 days of adjustment (as correctly calculated by the Office).

Applicants calculate a total PTO delay of 1072 days and Applicants delay of 281 days, for a revised total of 791 days of additional patent term. Based on the foregoing information, Applicants respectfully request reconsideration of the patent term adjustment.

Conclusion

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing Docket No. 377882000800.

Dated: November 14, 2008

Respectfully submitted,

Electronic signature: /Vicki L. Healy/
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